REMARKS/ARGUMENTS

I. Status of the Claims

Claims 129-202 are pending. Claims 129-143, 146, 147 and 155-202 are withdrawn. Claims 144, 145 and 148-154 are currently presented. Claims 145, 158, 200 and 201 have been amended. No new claims have been added.

II. Election/Restriction

The Examiner has withdrawn claims 129-143, 146, 147 and 155-202 from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. The Examiner states that election was made without traverse in the reply filed on November 1, 2006. The record shows that this characterization of the election is inaccurate.

On August 8, 2006, Applicants filed a response to the Requirement for Restriction/Election mailed April 13, 2006. In the response, Applicants elected Group II (claims 144-157) of the allegedly distinct groups of inventions **with** traverse. Applicants further made an election of species in compliance with 37 CFR 1.143.

On October 13, 2006, the Examiner mailed a Miscellaneous Action, alleging that the response mailed August 8, 2006, was not fully responsive for not providing "identification of the claims encompassing the elected invention."

On November 1, 2006, Applicants filed a response to the Miscellaneous Action of October 13, 2006. In the response, Applicants noted that the elected invention was encompassed by claims 144-145 and 148-154 of Group II.

At no point was election made without traverse. Applicants therefore respectfully request reconsideration of the requirement for restriction and rejoinder of the claims previously withdrawn.

III. Oath/Declaration

The Examiner alleges that the oath or declaration is defective because non-initialed and/or non-dated alterations have been made to the oath or declaration. Applicants have

submitted herewith an Application Data Sheet and a Declaration for Utility or Design Application Using an Application Data Sheet. Applicants believe that the declaration is now in proper form.

IV. Objection to the Abstract under 37 C.F.R. § 1.72

The Examiner has objected to the abstract, which allegedly does not allow the public generally to determine quickly from a cursory inspection the nature and gist of the claimed invention. Applicants have amended the abstract to correspond to independent claim 144 and respectfully request withdrawal of the objection.

V. Claims Rejected under 35 USC § 112

The Examiner has rejected claims 145 and 148 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states that claims 145 and 148 are indefinite for reciting an analyte that is a member selected from a group consisting of phases of matter, not analytes. Applicants have amended claim 145 to recite that "the phase of said analyte is a member selected from the group consisting of vapors, gases and liquids." Applicants therefore respectfully request withdrawal of the rejection.

VI. Claims Rejected under 35 USC § 102(e)
Over Abbott et al. (US Patent No. 6,284,197)

The Examiner has rejected claims 144, 145 and 148-154 under 35 USC § 102(e) as allegedly being anticipated by US Patent No. 6,284,197 to Abbott et al.

35 USC § 102(e) provides that a patent will not be granted if "the invention was described in . . . a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent[.]" (emphasis added) "Another" means a different inventive entity. MPEP 2136.04 (citing *In re Land*, 368 F.2d 866 (CCPA 1966)). The inventive entity is different if not all inventors are the same. *Id.* The inventors for both the Abbott patent and the instant subject matter are identical to each other. Applicants also note that the Abbott patent has been incorporated by reference to U.S. Application No. 09/127,382 and U.S. Patent No. 6,284,197 on page 1 of the amended specification. The Abbott patent is

therefore not available as a reference under 35 USC § 102(e), and Applicants respectfully request withdrawal of the rejection.

VII. Claims Rejected under 35 USC § 102(b)

Over Gupta et al., Science 279:2077-2080 (1998)

The Examiner has rejected claims 144, 145 and 148-154 under 35 USC § 102(b) as allegedly being anticipated by Gupta et al., *Science* 279:2077-2080 (1998).

35 USC § 102(b) provides that a patent will not be granted if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year* prior to the date of the application for patent in the United States[.]" (emphasis added) The date of the application is the effective filing date. *See* MPEP 706.02(a)(II)(A). The article by Gupta referenced by the Examiner was published on March 27, 1998. The effective filing date of the instant application is June 5, 1998, which is the filing date of the earliest application (09/092,453) to which this application claims priority. Because *Gupta* was not published more than one year prior to the effective filing date of the instant application, it is not available as a reference under 35 USC § 102(b). Applicants therefore request withdrawal of the rejection.

VIII. Gupta is unavailable as a reference under 35 USC § 102(a)

Applicants further note that a disclosure of Applicants' own work within the year before the application filing date cannot be used against them under 35 USC § 102(a). MPEP 2132.01 (citing *In re Katz*, 687 F.2d 450 (CCPA 1982)). An article cannot be used as a basis for a rejection under 35 USC 102(a) if Applicants submit a declaration establishing that the article is describing Applicants' own work. *Id.*

Gupta was published in *Science* on March 27, 1998, and was authored by Vinay Gupta, Justin Skaife, Timothy Dubrovsky and Nicholas Abbott. Since the earliest priority date of the instant application is June 5, 1998, *Gupta* was published within the year before the application filing date.

Applicants note that *Gupta* was cited by the Examiner as a reference under 35 USC § 102(a) during prosecution of U.S. Patent No. 6,284,197, whose inventors are identical to the

Applicants of the instant application. In response, Applicants submitted a *Katz* declaration, in light of which the rejection under § 102(a) was withdrawn. Thus, the previously submitted *Katz* declaration, a copy of which is enclosed as Exhibit A, is sufficient to establish that the subject matter disclosed in *Gupta* is Applicants' own work. For the same reasons that *Gupta* could not serve as a § 102(a) reference against the '197 Patent, it is not available as a § 102(a) reference against the instant application.

IX. Double Patenting

The Examiner has rejected claims 144, 145 and 148-154 on the ground of nonstatutory double patenting over claim 1 of US Patent No. 6,852,285, alone or in view of Gupta et al., *Science* 279:2077-2080 (1998).

The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC § 103(a) rejection. MPEP 804(II)(B)(1). A reference that cannot be cited for purposes of 35 USC § 102 cannot be cited as a reference under 35 USC § 103. MPEP 2141.01(I). As stated above, *Gupta* is not available as a reference under 35 USC § 102(a) or 102(b), and hence cannot be used as a reference under 35 USC § 103(a).

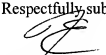
Nevertheless, Applicants have herewith filed a terminal disclaimer and therefore respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000.

Respectfully submitted,



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